

REMARKS

Claims 1-12 are pending and at issue.

The undersigned wishes to thank the Examiner for rejoining claims 9-12 which had been improperly withdrawn. In this regard, it is noted that claims 9 and 12 have now been rejected for the first time, and accordingly, it is believed that the finality of the rejection is improper because Applicant has not had an opportunity to argue these specific rejections and the new grounds for rejection were not necessitated by any amendment by the Applicant.

Additionally, it was noted in the remarks of Applicant's prior Response and during the telephone interview of January 7, 2008 referenced therein that the prior Office Action had not addressed Applicant's arguments contained on page 5, paragraph 3 of Amendment "A", which were incorporated by reference, and thus argued again in Applicant's receiving the current Office Action. However, the present Office Action again does not address those arguments and again places the Applicant in the position of not knowing the Examiner's position with respect to that argument. In this regard, the argument as presented in Amendment "A" is still applicable to the present rejection and Office Action. To wit, both the Office Action responded to by Amendment "A" and the present Office Action fail to state any rationale or cite any evidence whatsoever for its proposed modification of Kingman with Hays. Absent such a rationale, the rejection fails to meet the standards set forth in the MPEP for stating a *prima facie* case of obviousness and accordingly, it is improper and should be withdrawn. For this additional reason, it is believed the finality is improper and a new Office Action is respectfully requested addressing the above-refer-

enced argument from Amendment "A" and from Applicant's Response filed on January 7, 2008 so that Applicant can understand the Examiner's position in this regard and make a better determination on how to proceed with the prosecution of the application. In this regard, it should be noted that MPEP §706.07 expressly states that "Before final rejection is in order a clear issue should be developed between the Examiner and the Applicant." In this case, the issue with respect to the use of Hays in the rejection is not clear because Applicant has no idea of the Examiner's position with respect to Applicant's arguments in this regard.

In order to make this response complete, the rejection of claims 1, 2, 5 and 6 as unpatentable over Kingman 2,386,900 in view of Meyer 5,429,545 is respectfully traversed. In Applicant's prior response it was pointed out that references cannot be combined where references teach away from their combination (see MPEP §2145 x.2), and the Kingman expressly states that its object is to provide a scouring device having "a substantially rigid body or core" (Kingman, col. 1, lines 8-1) and consistent with this object, repeatedly teaches that its scouring device should have a rigid body or block (see, for example, col. 1, lines 41-46 and the first line of each of claims 1-5). Despite this overwhelming showing in Kingman, the present Office Action asserts that "The examiner could find no evidence in Kingman that teaches away from providing a material that would conform to the shape of the workpiece, especially as Kingman teaches that the abrasive coating has a flexible property that does conform slightly to the shape of the workpiece." However, this assertion misses the mark in that the rejection's proposed combination isn't asserting that the modification is to generally provide a material that would conform to the

shape of the workpiece, but specifically proposes that the “substantially rigid body or core” expressly required in Kingman be replaced with the “flexible, compressible polyurethane (polymer) foam” of Meyer. It is that specific substitution required by the proposed modification to reject the claims that is expressly taught away from by Kingman’s requirement that it have a substantially rigid body or core. For this reason alone, the proposed modification in the rejection is improper, as is the rejection, which should be withdrawn.

Furthermore, as was previously argued, the present rejection and the prior rejection assert that “it would have been obvious to one skilled in the art to substitute one material for the other to achieve the predictable result of a hand tool that conforms to the shape of the workpiece.” (emphasis added) As noted in Applicant’s prior response, this benefit is already expressed achieved by the structure in Kingman. In response to this, the present Office Action erroneously asserts that “Kingman teaches that the curved surfaces may be selected to conform to the shape of the workpiece, but does not teach that the material of the tool may be selected to conform to the shape of the workpiece.” (emphasis added) Contrary to this assertion, Kingman expressly states at column 3, lines 45-54 that “Since the coating 19 of the device is, per se, of resilient character, the same will sufficiently yield under pressure toward the surface undergoing treatment as to assure intimate conforming contact therewith, and so as to further assure that the abrasive material or grit 20 carried thereby will be brought into intimate and firm scraping and scouring engagement with said surface, when the device is rubbed back and forth over the latter.” Thus, Kingman’s disclosure that “the material of the tool” was “selected to conform to the shape of the workpiece” could not be any clearer, and the benefit argued in the rejection is thus already

expressly achieved by the unmodified structure in Kingman. As noted in Applicant's prior response, no rationale is provided in the rejection as to why the proposed modification would provide a superior result with respect to conforming to the shape of the workpiece than what is already expressly achieved by Kingman. Accordingly, for this additional reason, the rejections based on the modification of Kingman with Meyer is improper and should be withdrawn.

The rejections of claims 3, 4, 7 and 8 as unpatentable over Kingman in view of Meyer as applied to claim 1 and further in view of Hays 2,553,254 is additionally traversed for the reasons stated above in connection with the rejection of claim 1.

In view of the foregoing, Applicant respectfully requests reconsideration of the finality of the rejection and the rejections of claims 1-12, and allowance of the case.

Respectfully submitted,

WOOD, PHILLIPS, KATZ,
CLARK & MORTIMER

By



Jeffery N. Fairchild
Reg. No. 37,825

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500 West Madison Street
Suite 3800
Chicago, IL 60661
(312) 876-1800